



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/627,217

07/25/2003

James T. Caudle

24059-3

2428

7590

10/05/2004

Woodard, Emhardt, Moriarty,
McNett & Henry LLP
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

EXAMINER

GONZALEZ, MADELINE

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,217

Applicant(s)

CAUDLE, JAMES T.

Examiner

Madeline Gonzalez

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

In response to applicant's amendment dated July 22, 2004

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4, 5 and 8 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over John P. Smith in view of Klimek (U.S. 2,606,371).

John P. Smith discloses a tool, as shown in page 1, including:

- a flange-contacting portion for contacting the flange of an I-beam along the line where the flange intersects the web of the beam, as shown in page 2;
- a flat measuring blade for measuring distances from said flange-contacting portion along the web of the beam, wherein said flat measuring blade is not "T-shaped";
- a blade-gripping portion for holding said flat, not "T-shaped" measuring blade;
- a bridging portion for connecting said measuring blade portion to said flange-contacting portion by bridging the beam flange, wherein said bridging portion terminates at one end in a blade-locking mechanism, wherein said blade-locking mechanism includes a gripping member perpendicular to said flange contacting

Art Unit: 2859

portion and sized to receive said flat measuring blade so that when said blade-locking mechanism is in its locked position the gripping member secures said flat measuring blade in a position such that the measuring blade is perpendicular to a line parallel to the flange;

- wherein said flange-contacting portion extends in both directions along the line where the flange intersects the web of the beam, relative to the position of the measuring blade; and
- a handle portion for providing a better grip on the tool.

Smith lacks a slotted gripping member.

With respect to the slotted gripping member.

With respect to the slotted gripping member: Klimek discloses a gauge, as shown in Fig. 1, having a blade-locking mechanism including a slotted gripping member 14 sized to receive a flat measuring blade 10, said blade-locking mechanism having a screw 28 to clamp the blade 10 and lock the member 14. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the blade-locking mechanism disclosed by Smith with the blade-locking mechanism taught by Klimek and having a slotted gripping member, in order to facilitate the replacement of the measuring blade.

Art Unit: 2859

3. Claims 2 and 6 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over John P. Smith in view of Klimek (U.S. 2,606,371) as applied to claims 1, 4, 5 and 8 above, and further in view of McDanel (U.S. 1,826,807).

John P. Smith and Klimek disclosed all the subject matter claimed above in paragraph 2 with the exception of a rib for contacting the flange.

With respect to the rib for contacting the flange: McDanel discloses a gauge, as shown in Fig. 1, having a leg including a projection 6 (rib) contacting the outside face of the beam flange opposite the beam web, said projection 6 (rib) providing accurate positioning of the gauge. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add a rib as taught by McDanel to the tool disclosed by John P. Smith as modified by Klimek in order to assure an accurate positioning of the tool, as already suggested by McDanel.

Response to Arguments

4. Applicant's arguments with respect to claims 1, 2, 4-6 and 8 have been considered but are moot in view of the new ground(s) of rejection.

5. In response to applicant's argument that the used of the Smith reference under 102(a) was improper: 102 (a) applies when "the invention was known or used by others in this country, or

Art Unit: 2859

patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent". The Smith reference was known by "others" since Smith can be considered to be "others". "The term "others" refers to any entity which is different from the inventive entity and the entity need only to differ by one person to be "by others" (See MPEP 2132 (III)). In this case Smith is a different entity than the inventive entity.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Davidson, Jr. discloses a tool having a blade-locking mechanism having a slotted gripping member.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2859


however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (571) 272-2243. The examiner can normally be reached on Monday-Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MG


Diego F.F. Gutierrez
Supervisory Patent Examiner
Technology Center 2800

CHRISTOPHER W. FULTON
PRIMARY EXAMINER